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*KLM*

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/945,144	01/20/98	LEBRUN	M RP/PCT

CONNOLLY & HUTZ  
PO BOX 2207  
WILMINGTON DE 19899-2207

HM22/1121

 EXAMINER

KRUSE, D

ART UNIT	PAPER NUMBER
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1638

17

**DATE MAILED:**

11/21/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

File Copy

<b>Office Action Summary</b>	Application No.	Applicant(s)
	08/945,144	LEBRUN ET AL.
	Examiner David H Kruse	Art Unit 1638

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --***Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) Responsive to communication(s) filed on \_\_\_\_\_.

2a) This action is **FINAL**.                            2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) Claim(s) 30-35 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 30-35 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved.

12) The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. § 119**

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) All b) Some \* c) None of:

- Certified copies of the priority documents have been received.
- Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
- Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

**Attachment(s)**

15) Notice of References Cited (PTO-892)                            18) Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_

16) Notice of Draftsperson's Patent Drawing Review (PTO-948)                            19) Notice of Informal Patent Application (PTO-152)

17) Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5 and 8.                    20) Other: \_\_\_\_\_

### **DETAILED ACTION**

1. Cancellation of claims 1-18 and the addition of claims 19-29 in Paper No. 6 filed 23 March 1998 is acknowledged. Subsequent cancellation of claims 19-29 and the addition of claims 30-35 in Paper No. 9 filed 25 October 1999 is acknowledged. Claims 30-35 are pending.

#### ***Sequence Rules***

2. Applicant's response to the requirement for compliance to the Sequence Rules in Paper No. 16, filed 25 October 2000 is deemed incomplete. Specifically, Applicant must amend the Specification to recite the appropriate SEQ ID NO: on pages 6, 15, 16, 19 and 20 as set forth in the Sequence Rules (see U.S.C. 37 CFR 1.821(d)).

3. Full compliance with the Sequence Rules is required in response to this Official action. A complete response to this Official action should include both compliance with the Sequence Rules and a response to the issues set forth below. Failure to fully comply with both of these requirements in the time period set forth in this Office action will be held to be non-responsive.

#### ***Specification***

4. This application does not contain an abstract of the disclosure as required by 37 CFR 1.72(b). An abstract on a separate sheet is required.

5. The following guidelines illustrate the preferred layout and content for patent applications. These guidelines are suggested for the applicant's use.

#### ***Arrangement of the Specification***

The following order or arrangement is preferred in framing the specification and, except for the reference to "Microfiche Appendix" and the drawings, each of the lettered

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items should appear in upper case, without underlining or bold type, as section headings. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) Title of the Invention.
- (b) Cross-References to Related Applications.
- (c) Statement Regarding Federally Sponsored Research or Development.
- (d) Reference to a "Microfiche Appendix" (see 37 CFR 1.96).
- (e) Background of the Invention.
  - 1. Field of the Invention.
  - 2. Description of the Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (f) Brief Summary of the Invention.
- (g) Brief Description of the Several Views of the Drawing(s).
- (h) Detailed Description of the Invention.
- (i) Claim or Claims (commencing on a separate sheet).
- (j) Abstract of the Disclosure (commencing on a separate sheet).
- (k) Drawings.
- (l) Sequence Listing (see 37 CFR 1.821-1.825).

***Claim Objections***

6. Claim 35 is objected to because of the following informalities: It is recommended that "which plant" in line 2 be changed to the standard claim language -- wherein said plant --.

***Claim Rejections - 35 USC § 101***

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 30, and 32-34 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. As presently worded these claims read on naturally occurring mutant DNA and nontransformed plants and plant cells which are products of nature, and as such are non-statutory subject matter.

Amendment of Claim 30 to insert -- isolated -- or -- modified -- and amendment of claims 32-34 to insert -- transformed -- or -- transgenic -- would obviate this rejection.

***Claim Rejections - 35 USC § 112***

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

9. Claims 30 and 32-35 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 30 lacks an article of language, -- The DNA -- should be used to clarify the claimed invention.

At claims 32 and 33, the word "contains" does not particularly point out Applicant's invention, it is suggested that -- comprises -- be used instead.

At claim 35, Applicant has not defined the "agricultural method". A clearly defined utility is required, for example, -- A method of controlling weeds -- or -- A method of protecting plants from herbicidal damage -- .

***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10. Claims 30-35 are provisionally rejected under the judicially created doctrine of double patenting over pending claims of copending Application No. 08/945,821. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows: The sequence of SEQ ID NO:4 is disclosed in both Applications. Although the copending Application does not specifically claim SEQ ID NO: 4, a vector comprising SEQ ID NO: 4, a plant cell or plant comprising SEQ ID NO:4 or a method utilizing said plant, it does claim the genus encompassed by the instant application.

Furthermore, there is no apparent reason why Applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David H. Kruse, Ph.D. whose telephone number is (703) 306-4539. The examiner can normally be reached on Monday to Friday from 8:00 a.m. to 4:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Paula Hutzell can be reached at (703) 308-4310. The fax phone number for this Group is (703) 308-4242 or (703) 305-3014.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1234.



**AMY J. NELSON, PH.D  
PRIMARY EXAMINER**

David H. Kruse, Ph.D.  
15 November 2000